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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,311	08/21/2001	Mayer A. Berg	1446.003US1	7982

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,311

Applicant(s)

BERG ET AL.

Examiner

Arthur Duran

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[Handwritten signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-42 have been examined.

Claim Rejections - 35 USC § 112

2. Regarding claim 36, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-23, 26-32, 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah (6,697,824) in view of Su (6,302,344).

Claim 1, 13, 17, 26, 30, 36, 38, 42: Bowman-Amuah discloses a method, apparatus comprising:

Bowman-Amuah discloses providing a video and associated content in an integrated package to target a user or group of users for goods or services (Fig. 14; col 34, lines 34-67; col 31, lines 60-67), that a group of users can be targeted (col 30, lines 50-59)

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Bowman-Amuah further discloses that the information can include a coupon (col 32, lines 25-44)

Bowman-Amuah further discloses that a wide range of information about user(s) can be tracked for targeting purposes (col 43, line 40-col 44, line 20; col 45, lines 57-67) including the grouping of users for targeting (col 43, lines 60-63; col 30, line 30-col 51, line 10; col 50, lines 40-45).

Bowman-Amuah further discloses targeted marketing and advertising to a user(s) based on common profile characteristics (col 54, line 24-col 55, line 44; col 59, lines 1-14).

Bowman-Amuah does not explicitly disclose that one or more offers are based on a prospective event common to a plurality of target consumers.

However, Bowman-Amuah discloses targeting a group of users based on information known about users (col 83, lines 19-26), tracking and updating user profile information (col 30, lines 50-59; col 36, lines 15-23; col 43, line 40-col 44, line 20), and the user receiving event reminders for any date or event of interest (col 37, lines 49-55; col 56, lines 45-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bowman-Amuah's information on a prospective event for a user to Bowman-Amuah's utilization of any type of information known about a user or users for targeting a user or group of users. One would have been motivated to do this in order to provide information to a user(s) that will more likely be of interest to that user(s).

Bowman-Amuah further discloses uniquely identifying a user(s) and also retaining user address information (col 36, lines 60-65; col 43, lines 58-col 44, line 4).

Bowman-Amuah Further discloses that the items or information can be mailed to the user (col 36, lines 55-60; col 44, lines 15-20).

Bowman-Amuah further discloses printing information (col 8, lines 12-15).

Bowman-Amuah does not explicitly disclose a label or that the coupon can be printed.

However, it would be obvious that a label is necessary for shipping and that a coupon or other product related information can be sent with any package of advertising information to the user. One would have been motivated to do this in order to provide a further incentives in a format preferred with a user(s).

Additionally, Su discloses shrink wrapping a video, affixing printed information on the video, affixing a label on the video and distributing it to users via mail (col 3, lines 16-25).

Su further discloses utilizing video that can be mailed for promoting products and services (col 1, lines 14-19; col 2, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Su's shrink wrapping package sent to a user for marketing purposes to Bowman-Amuah's targeted packages to a user that includes video, coupons, and user identification and Bowman-Amuah's shipping information to a user. One would have been motivated to do this in order to provide content in a user preferred format.

Claim 2-12: Bowman-Amuah and Su disclose the method of claim 1.

Bowman-Amuah discloses targeting a group of users based on information known about users (col 83, lines 19-26), tracking and updating user profile information (col 30, lines 50-59; col 36, lines 15-23; col 43, line 40-col 44, line 20), and the user receiving event reminders for any date or event of interest (col 37, lines 49-55; col 56, lines 45-60).

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Bowman-Amuah explicitly discloses a birthday or anniversary (col 37, lines 49-55; col 56, lines 45-60).

Bowman-Amuah does not explicitly disclose that the prospective event is a wherein the prospective event is a graduation, wherein the prospective event is a religious event, wherein the prospective event is a birth of a child, wherein the prospective event is a purchase of a home, wherein the prospective event is a purchase of an automobile, wherein the prospective event is seeking a new job, wherein the prospective event is an upcoming holiday, wherein the prospective event is a retirement, wherein the prospective event is a celebration.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bowman-Amuah's information on any type of prospective event for a user to Bowman-Amuah's utilization of any type of information known about a user(s) for targeting that user(s). One would have been motivated to do this in order to provide information to a user(s) that will more likely be of interest to that user(s).

Claim 14, 15, 16, 27, 28, 29: Bowman-Amuah and Su disclose the method of claim 1.

Bowman-Amuah does not explicitly disclose storing the video on magnetic tape, digital video disk, or compact disk.

However, Bowman-Amuah discloses the utilization of disk for storage, the use of video and other multimedia technologies, the utilization of any electronic medium for information delivery (col 4, lines 57-63; col 10, lines 43-48; col 21, line 65-col 22, line 10; col 26, lines 22-29) and that the video content can be stored in many forms (col 48, lines 27-33).

Additionally, Su discloses storing the video on magnetic tape (col 7, lines 2-9).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Bowman-Amuah video stored on a wide range of mediums can be stored on industry standards such as magnetic tape, digital video disk, or compact disk. One would have been motivated to do this in order to provide the content that is in a readily useable form for users.

Claim 18, 19, 31, 32: Bowman-Amuah and Su disclose the method of claim 1.

Bowman-Amuah does not explicitly disclose that the print piece includes a code or that the video includes a code.

However, Bowman-Amuah does disclose that all content can be uniquely identified, tracked as to its activity, and recorded as to its activity (col 34, lines 30-49; col 46, lines 20-30; col 65, lines 35-52; col 82, lines 55-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Bowman-Amuah's uniquely identified content to Bowman-Amuah's video and advertising content. One would have been motivated to do this in order to better identify which content a user is responsive to.

Claim 20: Bowman-Amuah and Su disclose the method of claim 1, and Bowman-Amuah further discloses that the plurality of target consumers are invited to make a purchase from one or more of the plurality of partners (col 30, lines 59-67; col 31, lines 29-39).

Claim 21: Bowman-Amuah and Su disclose the method of claim 1, and Bowman-Amuah further discloses that the plurality of target consumers are invited to visit a partner's business (col 32, lines 24-45; col 42, lines 20-27; col 43, lines 25-31).

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Claim 22: Bowman-Amuah and Su disclose the method of claim 21, and Bowman-Amuah further discloses that the partner's business includes a store (col 30, lines 59-67; col 31, lines 29-39; col 26, lines 20-29).

Claim 23: Bowman-Amuah and Su disclose the method of claim 21, and Bowman-Amuah further discloses that the partner's business includes a website (col 32, lines 24-45; col 42, lines 20-27; col 43, lines 25-31).

Claim 37: Bowman-Amuah and Su disclose the method of claim 36, and Bowman-Amuah further discloses that the coupons are adjusted based on information about a particular consumer of the plurality of target consumers (col 32, lines 24-44; col 30, lines 50-59).

Claim 39: Bowman-Amuah and Su disclose the method of claim 38, and Bowman-Amuah further discloses updating a database with consumer selection information from each target consumer responding to the offers (col 30, lines 50-59; col 36, lines 15-23; col 43, line 40-col 44, line 20).

Claim 40: Bowman-Amuah and Su disclose the method of claim 38, and Bowman-Amuah further discloses that a consumer enters a code into a website and wherein the consumer is identified by the code (col 32, lines 24-45; col 42, lines 20-27; col 43, lines 25-31).

Claim 41: Bowman-Amuah and Su disclose the method of claim 40, and Bowman-Amuah further discloses that the website adjusts offers made to the consumer based on information in a database (col 32, lines 24-44; col 30, lines 50-59).

4. Claims 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah (6,697,824) in view of Su (6,302,344) in further view of Eggleston (6,061,660).

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Claim 24, 25: Bowman-Amuah and Su' disclose the method of claim 1.

Bowman-Amuah further discloses directing the user to a website (col 31, lines 19-24) and the utilization of specials to attract customers (col 32, lines 25-44).

Bowman-Amuah does not explicitly disclose that the plurality of target consumers is invited to claim a prize.

However, Eggleston discloses that the plurality of target consumers is invited to claim a prize and that the targeted consumers are invited to visit a website (col 1, lines 20-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's promotion in the form of an offered prize to Bowman-Amuah's promotion and inviting a user to visit a website. One would have been motivated to do this in order to provide a promotion that is attractive to many users.

5. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah (6,697,824) in view of Su (6,302,344) in further view of Travisano (5,544,770).

Claim 33, 34, 35:

Bowman-Amuah and Su disclose the apparatus in claims 26, 33.

Bowman-Amuah nor Su explicitly disclose utilizing multiple labels or that the shrink wrap is clear or opaque.

However, Bowman-Amuah further discloses mailing items or information and the return of items (col 66, lines 5-10).

Su further discloses shrink wrapping a video, affixing a label onto the shrink wrapped video (col 3, lines 16-25).

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Su further discloses placing a second label on the video (col 19, lines 15-20).

Travisano discloses shrink wrap (col 1, lines 31-36) and that packaging can be clear or opaque (col 1, lines 27-33) and that a label can be read through the wrapping (col 1, lines 21-34).

Travisano further discloses multiple labels (col 1, lines 52-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Travisano's clear or opaque shrink wrapping and Su or Travisano's multiple labels with an information item to Bowman-Amuah's information mailed to a user that includes a user address and other related information in a package. One would have been motivated to do this in order to provide additional information about the item or information shipped such as return labels for item returns.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Barnett (6,321,208) further discloses the information or coupons, including variable content and variable contents, targeted to a user or group of users.

b. Moen (5,864,604) discloses profiling, video, and advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

2/27/04